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Dated: Oct. 27, 2003

Signature:

Jerry L. Mahurin
Jerry L. Mahurin

Docket No.: 47583/P029US/10205730
(PATENT)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 30 2003

Technology Center 2100

In re Patent Application of:
Steven R. Boye, et al.

Application No.: 08/827,634

Confirmation No.: 3941

Filed: April 9, 1997

Art Unit: 2176

For: METHOD AND APPARATUS FOR
IMPLEMENTING WEB PAGES HAVING
SMART TABLES

Examiner: W. Bashore

APPELLANT'S BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief is in furtherance of the Notice of Appeal, filed in this case on August 25, 2003. The fees required under § 1.17(f), are dealt with in the accompanying "TRANSMITTAL OF APPEAL BRIEF". This brief is transmitted in triplicate.

This brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Macromedia, Inc., 600 Townsend Street, San Francisco, CA 94103, by virtue of an Assignment executed June 17, 2002 and recorded in the USPTO on July 30, 2002

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 17 claims pending in the present application.

B. Current Status of Claims

1. Claims canceled: 6 and 7
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-5 and 8-19
4. Claims allowed: None
5. Claims rejected: 1-5 and 8-19

C. Claims On Appeal

The claims on appeal are claims 1-5 and 8-19

IV. STATUS OF AMENDMENTS

This Application, including claims 1-9, was filed on April 9, 1997. A first Office Action was mailed on May 3, 1999. The first Office Action rejected claims 1-9 under 35 U.S.C. §103 as unpatentable over Yamashita, U.S. Patent No. 5,555,362 (hereinafter *Yamashita*) in view of Borland, Quattro Pro User's Guide (hereinafter *Quattro Pro*) and further in view of Lemay, *Teach Yourself Web Publishing with HTML in a Week* (hereinafter

Lemay). An “Amendment and Response” amending claims 1-5 and 8-9, canceling claims 6 and 7 and adding claims 10-19 was filed in response to the first Office Action on August 3, 1999 and was entered on August 6, 1999.

A first Final Office Action was mailed in this case on March 22, 2000 rejecting claims 1-5 and 8-18 under 35 U.S.C. §103 as unpatentable over *Yamashita* in view of *Quattro Pro* and further in view of *Lemay*. Claim 19 was rejected under 35 U.S.C. §103 as unpatentable over *Yamashita*, *Quattro Pro*, *Lemay*, and further in view of Oliver, D. et al., *Netscape 3 Unleashed*, (hereinafter *Netscape*). On September 27, 2000 a Notice of Abandonment was mailed. On October 3, 2000 a “Petition to Revive” and “Continued Prosecution Application Request” were filed in this case by hand delivery to the United States Patent and Trademark Office. A first “Preliminary Amendment” was filed via facsimile on December 8, 2000. The first Preliminary Amendment amended claims 1, 10 and 12 and argued for allowance of the claims.

A subsequent non-final Office Action was mailed on October 10, 2001 rejecting claims 1, 5, 8-12 and 14-17 as obvious in light of *Yamashita*, *Lemay* and Nielsen, U.S. Patent No. 5,897,644 (hereinafter *Nielsen*) and claims 2-4, 13, and 18 as obvious in light of *Yamashita*, *Lemay*, *Nielsen* and *Quattro Pro*. Following transfer of ownership and a resultant change in counsel, a “Petition to Revive” and “Amendment” were filed in response to the October 10, 2001 Office Action on June 6, 2002. This Amendment amended claims 1, 8, 9, 10, 11 and 12 and addressed the rejection of the October 10, 2001 Office Action. The June 6, 2002 Amendment pointed out that *Yamashita* and *Quattro Pro* are “non-analogous” art relative to the present application and went on to address the obviousness rejections of the claims *en arguendo* pointing out claim limitations not taught or suggested by the cited references and pointing out the lack of motivation to combine the references.

Another non-final Office Action was mailed on October 18, 2002 rejecting claims 1-5 and 8-19 under 35 U.S.C. 112, second paragraph as being vague and indefinite for including the phrase “susceptible to influence”. Claims 1-5 and 10-19 were rejected in the October 18, 2002 Office action under 35 U.S.C. §103(a) as unpatentable over Templeman, U.S. Patent No. 5,845,303 (hereinafter *Templeman*) in view of *Nielsen*, and claim 9 was rejected under 35 U.S.C. §103(a) as unpatentable over *Templeman* in view of *Nielsen* and further in view of

Lemay. An amendment was filed in Response on March 17, 2003, and a cited Exhibit inadvertently left out of the Amendment was faxed to the Examiner on March 26, 2003. The Amendment addressed a typographical error in claim 10 and pointed out the patentability of the claims. This Amendment pointed out that Applicants may be their own lexicographer and that the use of the phrase “susceptible to influence” does not make the claims indefinite as the use is not giving a meaning to the term repugnant to its usual meaning. Further, the Amendment of March 7, 2003 points out elements of the pending claims not taught or suggested by the cited references and highlights the lack of motivation to combine the cited references, other than through the use of impermissible hindsight.

The present Final Office Action was mailed on June 3, 2003, finally rejecting independent claims 1, 10, 11 and 12 under 35 U.S.C. §112, second paragraph, as indefinite for the use of the phrase “susceptible to influence”. The Final Office Action of June 3, 2003 also reiterated the earlier rejection of claims 1-5, 8 and 10-19 as obvious in light of *Templeman* and *Nielsen* and claim 9 as obvious in light of *Templeman*, *Nielsen* and *Lemay*. In response, Appellant filed a Notice of Appeal on August 25, 2003.

Accordingly, the claims enclosed herein as Appendix A incorporate all amendments to claims presented and entered including those presented in the Amendments of August 3, 1999; December 8, 2000; June 6, 2002; and March 7, 2003.

V. SUMMARY OF INVENTION

An embodiment of the present invention is a method for preserving a preferred presentation layout of a web page authored on a first computing system and rendered on one or more second computing systems, particularly where the layout is susceptible to influence by browser configuration on the second computing systems. The method may comprise obtaining a layout of display elements on a web page as discussed at least on page 9 through page 14 of the present specifications, referring to FIGURES 3 through 5. The method may further comprise using the first computing system to determine a primary split direction for the web page in order to preserve a preferred layout of the web page when rendered by a second computing system as discussed at least beginning on line 15 of page 14 and shown in FIGURES 6(a) and (b) and FIGURES 7(a)-(c). The method may also comprise determining splits of the web page, in the primary split direction as discussed beginning at the top of page

18 and continuing to line 6 of page 22, referring to FIGURES 10 through 15. Determining the primary split direction may include receiving input from a user (discussed on pages 14, line 15, and at line 19 of page 15), indicating the primary split direction or use of a default primary split direction. The primary split direction may be either vertical or horizontal. For a vertical primary split direction, software code may generate needed splits in a columnar orientation. For a horizontal primary split direction, the software code may generate needed splits in a row orientation. These orientations in relation to primary split direction are also discussed on pages 15 and 16. If the layout includes frames the software code may determine splits for each frame independently as discussed beginning on line 19 of page 17, referring to FIGURE 9.

The method may also include locking the size of selected text of the web page as discussed beginning on page 16, line 24, referring to FIGURES 8, 12(a) and 12(b). The web page may be displayed on a display screen as pointed out at least at line 7 of page 9. This display may include indications of the locations in of the determined splits as discussed on pages 15 and 16 of the specification. As discussed beginning on line 13 of page 22, an internal representation of the web page may be generated where the layout of the web page is primarily by rows or primarily by columns in accordance with the determined splits. This layout generation may be performed after receipt of a “publish” request from a user, similar to as discussed in the last sentence of page 8, or after receiving a “preview” request from the user.

As pointed out on line 9 of page 8, the aforementioned method steps may be embodied in a computer-readable storage medium storing program code for causing a computer to perform the steps or other means to provide a system for preserving a preferred presentation layout of a web page authored on a first computing system and rendered on one or more second computing systems, wherein, the layout is susceptible to influence by browser configuration on the second computing systems.

VI. ISSUES

(A) Whether claims 1-5 and 8-19 are vague and indefinite under 35 U.S.C. 112, second paragraph.

(B) Whether claims 1-5 and 10-19 are unpatentable under 35 U.S.C. §103(a) over *Templeman* in view of *Nielsen*; and

(C) Whether claim 9 is unpatentable under 35 U.S.C. §103(a) over *Templeman* in view of *Nielsen* and further in view of *Lemay*.

VII. GROUPING OF CLAIMS

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below:

<u>Group</u>	<u>Claims</u>
I.	Claim 1
II.	Claim 2
III.	Claim 3
IV.	Claim 4
V.	Claim 5
VI.	Claim 8
VII.	Claim 9
VIII.	Claim 10
IX.	Claim 11
X.	Claim 12
XI.	Claim 13
XII.	Claim 14
XIII.	Claim 15
XIV.	Claim 16
XV.	Claim 17
XVI.	Claim 18
XVII.	Claim 19

The claims do not stand or fall together. In Section VIII below, Appellant presents arguments why the claims subject to the same rejection are separately patentable, as required by M.P.E.P. § 1206.

VIII. ARGUMENTS

A. General

As noted above, claims 1-5 and 8-19 stand finally rejected as vague and indefinite under 35 U.S.C. 112, second paragraph; claims 1-5, 8 and 10-19 stand finally rejected under

35 U.S.C. §103(a) as being unpatentable over *Templeman* in view of *Nielsen*; and claim 9 stands finally rejected under 35 U.S.C. §103(a) as being unpatentable over *Templeman* and *Nielsen* in view of *Lemay*. Appellant hereby traverses the outstanding rejections of the claims, and requests reconsideration and withdrawal of the outstanding rejections in light of the arguments appearing below. Claims 1-5 and 8-19 are currently pending in the present application.

As discussed in greater detail below, independent claims 1, 10, 11 and 12 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite and claims 2-6, 8-9, and 13-19 stand rejected for incorporating the alleged deficiencies of their respective base claims. Specifically, the worlds “susceptible to influence” in claims 1, 10, 11 and 12 are asserted by the Final Office Action as being vague and indefinite. Further, the Final Office Action states “It is unclear if said claimed layout is actually being influenced.” In addressing Appellant’s earlier arguments the Final Office Action goes on to state:

“... the claimed phrase in question can be interpreted as likely to be influenced (i.e., liable or subject to influence). It does not necessarily mean that the layout will be influenced by a browser configuration. Instead, it means that said layout is “subject” to influence.”

As the Board is aware, an Applicant may be his own lexicographer, *Lear Siegler, Inc. v. Aerogrip Corp.*, 221 USPQ 1025, 1031 (Fed. Cir. 1984). Appellant also respectfully point out that according to the M.P.E.P. §2173.02, the Examiner “should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness.”

With regard to the obviousness rejections of claims 1-5 and 6 through 19 discussed in detail below, Appellant wishes to point out that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. As discussed below various ones of these criteria, particularly the first and/or third criteria are not satisfied by the various obviousness rejections of claims 1-5 and 8-19.

B. The claim of Group 1 (Claim 1)**1. Rejections under 35 U.S.C. §112, second paragraph**

Appellant submits that the use of the phrase “susceptible to influence” does not make claim 1 indefinite. Appellant asserts that the use of the term “susceptible to influence”, particularly in the context it is presented in claim 1 where the “layout is susceptible to influence by browser configuration on said one or more second computing system” is not giving a meaning to the term repugnant to its usual meaning. Since the Final Office Action states “It is unclear if said claimed layout is actually being influenced” (emphasis added). As noted in the response filed March 17, 2003, *Webster’s Encyclopedic Unabridged Dictionary* defines “susceptible” as “2. “accessible or especially liable or subject to some influence, mood, agency, etc.”, 1996, p. 1917, a copy of which is attached hereto as Exhibit 1. Therefore, the use of “susceptible to influence” in claim 1 is clearly in agreement with the common and ordinary meaning of the word “susceptible” and is not giving a meaning to the term repugnant to its usual meaning. The Final Office Action’s response to Appellant’s earlier presented argument only serves to reinforce Appellant’s argument. In the Final Office Action the Examiner states: “...it [the phrase “susceptible to influence”] means that said layout is “subject” to influence” (bracketed clarification added). Thus, the claim is not vague or indefinite as the Examiner “should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness” as provided by M.P.E.P. §2173.02. Since the Examiner is able to parse a meaning from the claim language consistent with the common and ordinary meaning of the questioned phrase, Appellant respectfully contends that claim 1 defines the subject matter with a reasonable degree of particularity and distinctness. Therefore, Appellant respectfully requests that the Board withdraw the 35 U.S.C. §112, second paragraph, rejection of claim 1.

2. Rejections under 35 U.S.C. §103(a)

In its rejection of independent claim 1, the Final Office Action admits that *Templeman* does not teach having a “layout presentation influenced by browser configuration.” The Final Office Action attempts to cure this deficiency by introducing *Nielsen*, which the Final Office Action alleges to teach having “a transformation that transforms a web page (preserving an aspect ratio), for display in an HTML processing application (i.e. a web browser) in output

devices of differing sizes.”. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Independent claim 1 defines “determining, using a first computing system, a primary split direction for the web page” and “determining splits of the web page, in the primary split direction”. *Templeman* as modified by *Nielsen* does not disclose at least these limitations.

As discussed at column 5, lines 30 through 52, and discussed in the Final Office Action’s response to Appellant’s earlier arguments, *Templeman* discloses a metaform employing frames in the form of a dynamic template defined to receive specific items of information. Each of the frames are defined to receive either text or graphics data. For example, frames 88 and 90 contain the body of the newsletter. Examples of metaforms listed include memos, business letters, newspaper articles, electronic mail messages, technical reports, and the like. The type of data each frame may accept is determined by a tag or set of tags which identifies the frame as accepting certain data. These tags correspond to tags used to identify input data.

The Final Office Action states “It is noted that said newsletter frameset (Figure 3A) incorporates two main body columns, separated by a main vertical split which is determined by the template. This can be interpreted as a primary split direction, said split direction typical of many newsletters and newspapers.”. However, as cited by the Final Office Action and taught by *Templeman*, at column 8, lines 60-65, “distances between columns 130d or widths of columns 130e, 130f may also be defined using required constraints”. *Templeman* also states that “A constraint describes a relationship that must hold between multiple variables. For example, a constraint can be defined which will maintain an alignment between two objects...constraints are employed to maintain consistent relationships between frames as the frames change size and/or location on the display device 44.” Therefor, *Templeman* requires that column or row relationships be defined as constraints. In other words, the metaforms of *Templeman* defines or sets column spacing while the present invention determines both a primary direction of splits on a web page and the splits themselves, in that primary direction. Furthermore, *Templeman* is silent as to splits in general and as to determining a primary direction of splits on a web page. Any splits and their directions present in *Templeman* are predefined in the metaform.

Thus, *Templeman* does not teach the claimed “determining a primary split direction...for a web page” or “determining splits of the web page, in the primary split direction” and *Nielsen* is not relied upon as teaching this limitation. Therefore, for at least these reasons Appellant respectfully assert claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Independent claim 1 also defines a “layout is susceptible to influence by browser configuration”. Despite the contention of the Final Office Action, *Nielsen* does not disclose this limitation. As shown in FIGURES 9A through 9C of *Nielsen*, and discussed in the abstract, *Nielsen* discloses “a page layout similar to that of the original but magnified or reduced to fit the available display area” (emphasis added). Furthermore, at column 3, lines 32 through 37 *Nielsen* states “the invention specifies the size of the fixed canvas used to create the presentation and transforms (reducing or enlarging) the canvas and image (resulting from processing the HTML data stream) to fit on a display with a different size than the display used to create the original presentation”. The disclosure of *Nielsen* seems be limited to issues of display and font size, not all aspects of a web page layout that are susceptible to influence by browser configuration, such as browser default font sizes which would block or otherwise interfere with the font resizing taught by *Nielsen* and which can be compensated for by the determination of splits as recited in independent claim 1. The statement in the Final Office Action in response to Appellant’s earlier arguments that: “Since the font for said web page can be considered a default font size, the resizing by Nielsen changes the size of the text, therefore the appearance of the font changes” fails to address the Appellant’s earlier contention, reiterated here that Nielsen only deals with issues of display and font size, not all aspects of a web page layout that are susceptible to influence by browser configuration. Therefore, Appellant respectfully assert that for at least this reason claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

3. Examiner’s Personal Knowledge

In the rejection of claim 1, the Final Office Action states “It is noted that said newsletter frameset (Figure 3A) incorporates two main body columns, separated by a main vertical split which is determined by the template. This can be interpreted as a primary split direction, said split direction typical of many newsletters and newspapers.” (Emphasis added.) In light of this statement by the Examiner, Appellant in the March 17, 2003

Amendment expressed a belief that Examiner had either relied on his own personal knowledge, or taken Official Notice, with respect to these matters. Under Rule 37 C.F.R. §1.104(d)(2), the Examiner was requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertions or under M.P.E.P. §2144.03 cite a reference(s) in support of the assertions. In response the Examiner stated, in part:

“Since newspaper columns are generally vertical, said columns typically separated by vertical areas of white space (“splits” for visually deferring each column), the newspaper designer can interpret these columns (and/or their vertical white space columns) as “primary splits”.”

Thus again, the Examiner has relied on personal knowledge by stating “the newspaper designer can interpret these columns (and/or their vertical white space columns) as “primary splits”.” Therefore, Appellant respectfully contends that the Final Office Action fails to meet the duty imposed by 37 C.F.R. §1.104(d)(2) and/or M.P.E.P. §2144.03 through the Examiner’s failure to provide an Affidavit or reference. Thus, the continued rejection of claim 1 is improper.

4. The Final Office Action does not provide the requisite motivation.

The Final Office Action admits that *Templeman* does not teach having a “layout presentation influenced by browser configuration.” The Final Office Action attempts to cure this deficiency by introducing *Nielsen*, which the Final Office Action alleges to teach having “a transformation that transforms a web page (preserving an aspect ratio), for display in an HTML processing application (i.e. a web browser) in output devices of differing sizes.”. The motivation for making the combination was presented as follows:

“It would have obvious to one of ordinary skill in the art at the time of the invention to apply Nielsen to Templeman, providing Templeman the benefit of web page display resizing within Templeman’s relationship constraints (Templeman column 8 lines 41-48) in web browsers for fitting various sized devices (i.e. laptops, PDAs, etc.).

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. Language such as advanced by the Final Office Action is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The statement

“providing Templeman the benefit of web page display resizing within Templeman’s relationship constraints... in web browsers for fitting various sized devices”, is merely a restatement of the proposed combination not a reason or motivation for making the combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of *Templeman* and *Nielsen* is desirable. The only response provided by the Examiner in response to Appellant’s earlier presented motivation argument is that in the combination of *Templeman* and *Nielsen*: “... the user is provided with the advantage of a complete web page regardless of its display size.” This fails to address what in these references or the art would motivate one to combine *Templeman* and *Nielsen*.

Further Appellant respectfully reasserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Appellant’s disclosure. Appellant asserts that without the teachings of Appellant’s disclosure one of ordinary skill in the art would not find it obvious to determine the direction of splits in a web page and then define splits in the determined direction from the disclosures of *Templeman* and *Nielsen*.

Templeman teaches the use of predefined metaforms employing frames in the form of a dynamic template defined to receive specific items of information. Each of the frames are defined to receive either text or graphics data, whereas *Nielsen* teaches magnifying or reduced a page layout to fit the available display. Therefore, each reference teaches a complete method for displaying a page without the need of the teachings of the other reference. Conversely, the teachings of each of the references would interfere or destroy the function of the other reference. The reduction or enlarging of a page would violate the constraints of *Templeman* and the use of constraints would prevent reduction and enlargement of a page as taught by *Nielsen*. It is well settled that the proposed modification cannot render the prior art unsatisfactory for its intended purpose, M.P.E.P. §2143.01. If the proposed modification rendered the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

The Examiner seems to be relying on the teachings of the present application to conclude that one of ordinary skill in the art would be motivated to resize a web page display within relationship constraints in a web browser for fitting various sized devices. It is respectfully asserted that such a conclusion ignores the teachings of both *Templeman* and *Nielsen*. The Examiner's response to the Appellant's earlier advancement of this argument is met with the cursory statement that: "It is respectfully submitted that hindsight reconstruction is not used in the instant rejections." The Final Office Action fails to point out what in either of these two references would lead to their combination absent the application of hindsight.

C. The claim of Group II (Claim 2)

Claim 2 depends directly from base claim 1 and thus inherits all limitations of claim 1. Resultantly, claim 2 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 1. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above in addressing the obviousness of claim 1, claim 2 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 2 meets the requirements of 35 U.S.C. §112.

D. The claim of Group III (Claim 3)

Claim 3 depends directly from base claim 1 and thus inherits all limitations of claim 1. Resultantly, claim 3 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 1. Furthermore, Appellant respectfully contends, contrary to the Final Office Action, that the "Transform Font Size" of *Nielsen* does not teach "enabling the size of selected text of the web page to be locked" as recited by claim 3. Therefore, Appellant respectfully asserts that claim 3 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 4 meets the requirements of 35 U.S.C. §112.

E. The claim of Group IV (Claim 4)

Claim 4 depends directly from base claim 1 and thus inherits all limitations of claim 1. Resultantly, claim 4 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness

rejection of independent claim 1. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above in addressing the obviousness rejection of claim 1, claim 4 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 4 meets the requirements of 35 U.S.C. §112.

F. The claim of Group V (Claim 5)

Claim 5 depends directly from base claim 1 and thus inherits all limitations of claim 1. Resultantly, claim 5 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 1. Furthermore, claim 5 recites; “generating an internal representation of the web page where the layout of the web page is primarily by rows or primarily by columns in accordance with the splits.” As the Final Office Action points out Templeman only “teaches a newsletter framset primarily showing two columns” not rows or columns in accordance with splits. Therefore, Appellant respectfully asserts that at least for these reasons claim 5 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 5 meets the requirements of 35 U.S.C. §112.

G. The claim of Group VI (Claim 8)

Claim 8 depends directly from base claim 5 and thus inherits all limitations of base independent claim 1 and base claim 5. Resultantly, claim 8 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejections of independent claim 1 and base claim 5. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above in addressing the obviousness rejection of claims 1 and 5, claim 8 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 8 meets the requirements of 35 U.S.C. §112.

Furthermore as admitted by the Final Office Action the cited references fail to teach a publish request. In the rejection of claim 8, the Final Office Action states “a publish request from a user would have been obvious to one of ordinary skill in the art at the time of the invention”. In light of this statement by the Examiner, Appellant in the March 17, 2003 Amendment expressed a belief that Examiner had either relied on his own personal

knowledge, or taken Official Notice, with respect to these matters. Under Rule 37 C.F.R. §1.104(d)(2), the Examiner was requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertions or under M.P.E.P. §2144.03, cite a reference(s) in support of the assertions. It seems the Final Office Action fails to address this request. Therefore, Appellant respectfully contends that the Final Office Action fails to meet the duty imposed by 37 C.F.R. §1.104(d)(2) and/or M.P.E.P. §2144.03 through the Examiner's failure to provide an Affidavit or reference. Thus the rejection of claim 8 would seem improper.

H. The claim of Group VII (Claim 9)

The Final Office Action admits that *Templeman* as modified *Nielsen* does not teach "a preview request." The Final Office Action attempts to cure this deficiency by introducing *Lemay* which the Final Office Action alleges to teach having "an HTML writer utilizing a Test (preview) button." However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 9 ultimately depend from independent base claim 1, through intermediate dependent claim 5, and thus inherits all limitations of claim 1. Resultantly, claim 9 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons as detailed above in relation to claim 1. Furthermore, *Lemay* is not relied upon as teaching any of the limitations absent from *Templeman* as modified by *Nielsen* discussed above. Therefore, Appellant respectfully assert that for this reason alone claim 9 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Furthermore, claim 5, the parent claim of claim 9, recites "generating an internal representation of the web page" and claim 9 itself defines "the generating step is performed after receiving a preview request from a user". *Lemay* does not disclose at least the emphasized limitation of claim 9's parent claim. *Lemay* states: "it [HTML Writer] has a test preview button that loads Mosaic or Cello to preview your work. Therefore, *Lemay* does not teach generation of an internal representation of a web page but rather teaches the loading of an external program to preview work. Thus, *Lemay* does not teach the claimed generating an internal representation of the web page after receiving a preview request from a user, and in

truth, teaches away from this limitation. The Final Office Action fails to address this aspect of claim 5.

The motivation for making the combination was presented as follows:

“It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Lemay to Templeman, providing Templeman the benefit of previewing a page after importation of HTML data, to see if said importation was successfully integrated.”

As noted above, it is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *Lemay* teaches away from the present invention. The third paragraph on page 326 of *Lemay* states: “on the other hand, if you go looking for a full-featured HTML editor that lets you quickly see the result of your work, insert links and anchors and inline graphics quickly and easily, or build a form using element widgets you can drag from a toolbox, you’ll be looking for a very long time” (emphasis added). Thus, *Lemay* teaches that the claimed elements of the present invention, namely, “preserving a preferred layout of said web page when rendered by one or more second computing systems, wherein said preferred layout is susceptible to influence by browser configuration on said one or more second computing systems” are absent from the prior art. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of *Templeman* as modified *Nielsen* with *Lemay* is desirable. Therefore, the rejection of claim 9 should be withdrawn.

Further, Appellant respectfully asserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Appellant’s disclosure. Appellant asserts that without the teachings of Appellant’s disclosure one of ordinary skill in the art would not find it obvious to provide *Templeman* as modified by *Nielsen* the benefit of previewing a page after importation of HTML data, to see if said importation was successfully integrated. As pointed out above *Lemay* teaches away from “a full-featured HTML editor that lets you quickly see the result of your work.”

The Examiner seems to be relying on the teachings of the present application to conclude that one of ordinary skill in the art would be motivated to providing modify the metaforms of *Templeman* to have the benefit of previewing a page. It is respectfully asserted that such a conclusion ignores the teachings of *Templeman*, *Nielsen*, and particularly the teachings of *Lemay*, which teaches away from a full-featured HTML editor.

Therefore, the Appellant respectfully assert that for at least all of the above reasons claim 9 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 9 meets the requirements of 35 U.S.C. § 112.

I. The claim of Group VIII (Claim 10)

As discussed in greater detail above, Appellant submits that the use of the phrase “susceptible to influence” does not make claim 10 indefinite and that claim 10 defines its subject matter with a reasonable degree of particularity and distinctness. Therefore, Appellant respectfully requests that the Board withdraw the 35 U.S.C. § 112, second paragraph, rejection of claim 10.

The Final Office Action states that it rejects independent claim 10 along the same rationale as used to reject independent claim 1. Independent claim 10 defines “means for determining a primary split direction for the web page, said primary split direction preserving a preferred layout of said web page when rendered by web browsers hosted by at least one other system, wherein said preferred layout is susceptible to influence by browser configuration on said web browsers hosted by at least one other system” and “means for determining splits for the web page, in the primary split direction.”

As noted above in addressing the obviousness rejection of independent claim 1, *Templeman* discloses a metaform employing frames in the form of a dynamic template defined to receive specific items of information. Each of the frames are defined to receive either text or graphics data. *Templeman* requires that column or row relationships be defined as constraints and is silent as to splits in general and as to determining a primary direction of splits on a web page. Any splits and their directions present in *Templeman* are predefined in the metaform. Thus, *Templeman* does not teach the claimed “ means for determining a primary split direction...for a web page” or “means for determining splits of the web page, in

the primary split direction” and *Nielsen* is not relied upon as teaching this limitation. Therefore, for at least these reasons Appellant respectfully assert claim 10 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Also independent claim 10 defines a “layout is susceptible to influence by browser configuration”. As discussed above in addressing the obviousness rejection of independent claim 1, the disclosure of *Nielsen* seems be limited to issues of display and font size, not all aspects of a web page layout that are susceptible to influence by browser configuration, which can be compensated for by the determination of splits as recited in independent claim 10. Further, the responses provided by the Final Office Action in answer to Appellant’s earlier arguments fail to address the Appellant’s earlier contention, reiterated above. Therefore, Appellant respectfully assert that for at least this reason claim 10 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Further, as pointed out above in addressing the rejection of independent claim 1, the motivation provided by the Examiner is improper. No valid suggestion has been made as to why a combination of *Templeman* and *Nielsen* is desirable. Furthermore, whereas each reference teaches a complete method for displaying a page without the need of the teachings of the other reference, and the teachings of each of the references would interfere or destroy the function of the other reference there is no suggestion or motivation to make the proposed modification. Finally, the Final Office Action seems to be relying on impermissible hindsight to piece together the cited references to reach claim 10.

J. The claim of Group IX (Claim 11)

As discussed in greater detail above, Appellant submits that the use of the phrase “susceptible to influence” does not make claim 11 indefinite and that claim 11 defines its subject matter with a reasonable degree of particularity and distinctness. Therefore, Appellant respectfully requests that the Board withdraw the 35 U.S.C. § 112, second paragraph, rejection of claim 11.

The Final Office Action states that it rejects independent claim 11 along the same rationale as used to reject independent claim 1. Independent claim 11 recites “determining a

primary split direction for the web page” and “determining splits in the web page, in the primary split direction.”

As noted above in addressing the obviousness rejection of independent claim 1, *Templeman* discloses a metaform employing frames in the form of a dynamic template defined to receive specific items of information. Each of the frames are defined to receive either text or graphics data. *Templeman* requires that column or row relationships be defined as constraints and is silent as to splits in general and as to determining a primary direction of splits on a web page. Any splits and their directions present in *Templeman* are predefined in the metaform. Thus, *Templeman* does not teach the claimed “determining a primary split direction for a web page” or “determining splits of the web page, in the primary split direction” and *Nielsen* is not relied upon as teaching this limitation. Therefore, for at least these reasons Appellant respectfully assert claim 11 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Also independent claim 11 defines a “layout is susceptible to influence by browser configuration”. As discussed above in addressing the obviousness rejection of independent claim 1, the disclosure of *Nielsen* seems be limited to issues of display and font size, not all aspects of a web page layout that are susceptible to influence by browser configuration, which can be compensated for by the determination of splits as recited in independent claim 11. Further, the responses provided by the Final Office Action in answer to Appellant’s earlier arguments fail to address the Appellant’s earlier contention, reiterated above. Therefore, Appellant respectfully assert that for at least this reason claim 11 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Further, as pointed out above in addressing the rejection of independent claim 1, the motivation provided by the Examiner is improper. No valid suggestion has been made as to why a combination of *Templeman* and *Nielsen* is desirable. Furthermore, whereas each reference teaches a complete method for displaying a page without the need of the teachings of the other reference, and the teachings of each of the references would interfere or destroy the function of the other reference there is no suggestion or motivation to make the proposed modification. Finally, the Final Office Action seems to be relying on impermissible hindsight to piece together the cited references to reach claim 11.

K. The claim of Group X (Claim 12)

As discussed in greater detail above, Appellant submits that the use of the phrase “susceptible to influence” does not make claim 12 indefinite and that claim 12 defines its subject matter with a reasonable degree of particularity and distinctness. Therefore, Appellant respectfully requests that the Board withdraw the 35 U.S.C. § 112, second paragraph, rejection of claim 12.

The Final Office Action states that it rejects independent claim 12 along the same rationale as used to reject independent claim 1. Independent claim 12 recites “a device for obtaining a primary split direction for the web page” and “memory storing software code for determining splits in the web page, in the primary split direction”. As noted above in addressing the obviousness rejection of independent claim 1, *Templeman* discloses a metaform employing frames in the form of a dynamic template defined to receive specific items of information. Each of the frames are defined to receive either text or graphics data. *Templeman* requires that column or row relationships be defined as constraints and is silent as to splits in general and as to determining a primary direction of splits on a web page. Any splits and their directions present in *Templeman* are predefined in the metaform. Thus, *Templeman* does not teach the claimed “a device for obtaining a primary split direction for the web page” and “memory storing software code for determining splits in the web page, in the primary split direction” and *Nielsen* is not relied upon as teaching this limitation. Therefore, for at least these reasons Appellant respectfully assert claim 12 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Also independent claim 12 defines a “layout is susceptible to influence by browser configuration”. As discussed above in addressing the obviousness rejection of independent claim 1, the disclosure of *Nielsen* seems be limited to issues of display and font size, not all aspects of a web page layout that are susceptible to influence by browser configuration, which can be compensated for by the determination of splits as recited in independent claim 12. Further, the responses provided by the Final Office Action in answer to Appellant’s earlier arguments fail to address the Appellant’s earlier contention, reiterated above. Therefore, Appellant respectfully assert that for at least this reason claim 12 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Further, as pointed out above in addressing the rejection of independent claim 1, the motivation provided by the Examiner is improper. No valid suggestion has been made as to why a combination of *Templeman* and *Nielsen* is desirable. Furthermore, whereas each reference teaches a complete method for displaying a page without the need of the teachings of the other reference, and the teachings of each of the references would interfere or destroy the function of the other reference there is no suggestion or motivation to make the proposed modification. Finally, the Final Office Action seems to be relying on impermissible hindsight to piece together the cited references to reach claim 12.

L. The claim of Group XI (Claim 13)

Claim 13 depends directly from base claim 12 and thus inherits all limitations of base independent claim 12. Resultantly, claim 13 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 12. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above in addressing the obviousness rejection of claim 12, claim 13 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 13 meets the requirements of 35 U.S.C. §112.

M. The claim of Group XII (Claim 14)

Claim 14 depends directly from base claim 12 and thus inherits all limitations of base independent claim 12. Resultantly, claim 14 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 12. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above in addressing the obviousness rejection of claim 12, claim 14 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 14 meets the requirements of 35 U.S.C. §112.

N. The claim of Group XIII (Claim 15)

Claim 15 depends directly from base claim 12 and thus inherits all limitations of base independent claim 12. Resultantly, claim 15 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 12. Therefore, Appellant respectfully asserts,

that at least for the reasons advanced above in addressing the obviousness rejection of claim 12, claim 15 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 15 meets the requirements of 35 U.S.C. §112.

O. The claim of Group XIV (Claim 16)

Claim 16 depends from base claim 15 and therethrough independent base claim 12. Thus claim 16 inherits all limitations of base claim 15 and independent claim 12. Resultantly, claim 16 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 12. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above in addressing the obviousness rejection of claims 15 and 12, claim 16 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 16 meets the requirements of 35 U.S.C. §112.

P. The claim of Group XV (Claim 17)

Claim 17 depends from base claim 15 and therethrough independent base claim 12. Thus claim 17 inherits all limitations of base claim 15 and independent claim 12. Resultantly, claim 17 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 12. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above in addressing the obviousness rejection of claims 15 and 12, claim 17 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 17 meets the requirements of 35 U.S.C. §112.

Q. The claim of Group XVI (Claim 18)

Claim 18 depends directly from base claim 12 and thus inherits all limitations of base independent claim 12. Resultantly, claim 18 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 12. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above in addressing the obviousness rejection of claim 12, claim 18 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 18 meets the requirements of 35 U.S.C. §112.

R. The claim of Group XVII (Claim 19)

Claim 19 depends directly from base claim 12 and thus inherits all limitations of base independent claim 12. Resultantly, claim 19 sets forth features and limitations not recited by the combination of *Templeman* and *Nielsen* for the same reasons detailed above in addressing the obviousness rejection of independent claim 12. Furthermore claim 19 recites: “the layout includes frames and wherein the software code determines splits for each frame independently.” Appellant respectfully contends that the sections of *Templeman* cited by the Final Office Action at best refers to relation ship between frames not splits within each frame. Therefore, Appellant respectfully asserts, that at least for the reasons advanced above claim 19 is patentable over the 35 U.S.C. § 103(a) rejection of record, and that claim 19 meets the requirements of 35 U.S.C. §112.

IV. Conclusion

For all the reasons given above, Appellant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. § 103, and meet the requirements of 35 U.S.C. §112. Accordingly, Appellants submit that this application is in full condition for allowance. Therefore, the Board is respectfully requested to withdraw the outstanding rejections of the claims and to remand this case for issuance.

IX. CLAIMS INVOLVED IN THE APPEAL

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Appellant on August 3, 1999; December 8, 2000; June 6, 2002; and March 7, 2003.

Appellant believes no fee beyond the appeal brief fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 47583/P029US/10205730 from which the undersigned is authorized to draw.

Dated:

Respectfully submitted,

By 

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 08/827,634

1. A method for preserving a preferred presentation layout of a web page authored on a first computing system and rendered on one or more second computing systems, wherein, said layout is susceptible to influence by browser configuration on said one or more second computing systems, said method, comprising:

obtaining a layout of display elements on a web page;

determining, using a first computing system, a primary split direction for the web page, preserving a preferred layout of said web page when rendered by one or more second computing systems, wherein said preferred layout is susceptible to influence by browser configuration on said one or more second computing systems; and

determining splits of the web page, in the primary split direction.

2. The method of claim 1, where the step of determining the primary split direction includes the step of receiving input from a user indicating the primary split direction.

3. The method of claim 1, further including the step of enabling the size of selected text of the web page to be locked.

4. The method of claim 1, further comprising displaying the web page on a display screen, including indications of the locations in of the determined splits.

5. The method of claim 1, further comprising generating an internal representation of the web page where the layout of the web page is primarily by rows or primarily by columns in accordance with the splits.

8. The method of claim 5, wherein the generating step is performed after receiving a publish request from a user.

9. The method of claim 5, wherein the generating step is performed after receiving a preview request from a user.

10. (Amended) A system comprising:
 - means for obtaining a layout of display elements on a web page;
 - means for determining a primary split direction for the web page, said primary split direction preserving a preferred layout of said web page when rendered by web browsers hosted by at least one other system, wherein said preferred layout is susceptible to influence by browser configuration on said web browsers hosted by at least one other system; and
 - means for determining splits for the web page, in the primary split direction.
11. A computer-readable storage medium storing program code for causing a computer to perform the steps of:
 - obtaining a layout of display elements on a web page;
 - determining a primary split direction for the web page, preserving a preferred layout of said web page when rendered by web browsers hosted by at least one other computer, wherein said preferred layout is susceptible to influence by browser configuration on said web browsers hosted by at least one other computer; and
 - determining splits in the web page, in the primary split direction.
12. A system for preserving a preferred presentation layout of a web page authored on a first computing system and rendered on one or more second computing systems, wherein, said layout is susceptible to influence by browser configuration on said one or more second computing systems, said system comprising:
 - a device for obtaining a layout of display elements on a web page, and a primary split direction for the web page preserving a preferred layout of said web page when rendered by various web browsers; and
 - memory storing software code for determining splits in the web page, in the primary split direction.
13. The system of claim 12, wherein the primary split direction is set by the user.
14. The system of claim 12, wherein the primary split direction is a default setting.
15. The system of claim 12, wherein the primary split direction is either vertical or horizontal.

16. The system of claim 15, wherein, for a vertical primary split direction, the software code generates needed splits in a columnar orientation.

17. The system of claim 15, wherein, for a horizontal primary split direction, the software code generates needed splits in a row orientation.

18. The system of claim 12, wherein the software code displays the web page indicating the splits.

19. The system of claim 12, wherein the layout includes frames and wherein the software code determines splits for each frame independently.